

Remarks

Independent Claim 1 has been amended to refer in the alternative to the plant with ATCC accession number PTA-904, or a first-generation hybrid of the plant with ATCC accession number PTA-904, or a second-generation hybrid of the plant with ATCC accession number PTA-904. Dependent Claims 31 and 54 have been amended to remove alternative limitations to plants other than the plant with ATCC accession number PTA-904.

Claims 171-175 were canceled as being redundant in light of the other amendments.

No other amendments have been made.

Basis for the amendment to Claim 1 is found, for example, in the specification at page 29, lines 12-14; and page 32, lines 3-5.

Claims 1-5, 7-9, 11, 13-15, 31, 38, 54, 61, 129-132, 134-136, 138, 140-146, 148-150, 152, 154-160, 162-164, 166, 168-170, and 176-185 remain in the application.

If any extension of time is required, please consider this paper a petition for the total extension of time required.

It is believed that no fee is due in connection with this paper. In the event that a fee is due, kindly refer to the general Deposit Account Authorization previously filed with the application.

Reexamination and reconsideration of the application, as amended, are respectfully requested.

Preliminary Comments; and a Request to the Examiner

Applicant's intent in presenting these amendments is not to surrender the canceled subject matter. To the contrary, it is Applicant's present intention to pursue the canceled subject matter in one or more continuation applications. Rather, the intention is to accelerate the prosecution of this application, to try to obtain prompt allowance. Commercial embodiments of some of the claimed

inventions are currently on the market; and unauthorized, infringing activity is believed to be occurring, at least on a small scale. The prompt allowance of a patent having Claims that would cover both the commercial embodiments and the suspected infringements could help to protect the Applicant's rights, before infringing activity became more widespread.

The current amendments are intended to satisfy the substance of the various objections raised in the August 10, 2004 Office Action. It is accordingly hoped that this Amendment will result in the prompt allowance of the pending Claims. In the alternative, should the Examiner identify any remaining issues, the Examiner is respectfully requested to contact the undersigned to schedule a telephone interview before further action is taken, to discuss whether it might be possible to resolve any such issues quickly, and to conclude the prosecution of this application.

4. The Written Description Rejection

It is respectfully submitted that the present amendment to Claim 1, the sole independent Claim, overcomes the written description rejection. Claim 1 now states that the rice plant is the plant with ATCC accession number PTA-904, or a first-generation hybrid of the plant with ATCC accession number PTA-904, or a second-generation hybrid of the plant with ATCC accession number PTA-904; and further states that the plant has the herbicide resistance characteristics of the plant with ATCC accession number PTA-904.

While reserving the right to present arguments concerning the canceled subject matter in the future, for example in a continuation application, it is respectfully submitted that the present amendment overcomes the written description rejection based on the broader recitation of "derivatives" of PTA-904.

In response to the first full paragraph on page 6 of the Office Action, the undersigned apologizes and regrets that certain remarks made in the Request for Continued Examination could be construed as suggesting that the Office had

intentionally specified how a third party might attempt to avoid infringement. Such a suggestion was never intended by undersigned, although with the benefit of hindsight the undersigned sees how his remarks could easily be so construed. Rather, the undersigned's intended point (presumably now moot) was that certain remarks by the Office might have had the unintended side effect described, not that the remarks were deliberately made for that purpose. The undersigned apologizes for the misunderstanding.

In any event, third parties who may review this prosecution history are hereby notified that, although claims to "derivatives" have been canceled from the present application in order to expedite prosecution, it is Applicant's intent to pursue the canceled subject matter in one or more continuation applications. Further discussion concerning "derivatives" is moot for the time being.

Data obtained since the application was filed confirm that the mutant AHAS from PTA-904 in fact behaves very similarly when incorporated into different genetic backgrounds. Cultivated rice has two principal subspecies, *Oryza sativa indica* and *Oryza sativa japonica*. As shown in the Declaration from inventor Dr. Timothy Croughan that was submitted with the January 12, 2004 RCE, the PTA-904 line has now been crossed with numerous other varieties as part of a breeding program. The herbicide resistance phenotype has been essentially constant in the offspring of all these crosses, including varieties of both subspecies *indica* and *japonica*. Thus the invention works as predicted by the disclosure in rice varieties and hybrids generally, and does not depend strongly upon the genetic background of a particular derivative. Thus the specification provides an adequate written description of first- and second-generation hybrids.

Strictly in the alternative, this ground of rejection should be withdrawn at least for Claims 31, 54, 129-132, 134-136, 138, 140-142, 157-160, 162-164, 166, 168-

170, and 183-185 each of which contains a further limitation directed to the rice plant with ATCC accession number PTA-904.

It is respectfully submitted that the written description rejection has been overcome and should be withdrawn.

5. The Enablement Rejection

It is respectfully submitted that the present amendment to Claim 1, the sole independent Claim, overcomes the enablement rejection. Claim 1 now states that the rice plant is the plant with ATCC accession number PTA-904, or a first-generation hybrid of the plant with ATCC accession number PTA-904, or a second-generation hybrid of the plant with ATCC accession number PTA-904; and further states that the plant has the herbicide resistance characteristics of the plant with ATCC accession number PTA-904.

While reserving the right to present arguments about the canceled subject matter in the future, for example in a continuation application, it is respectfully submitted that the amendment overcomes the enablement rejection based on the broader recitation of "derivatives" of PTA-904.

Strictly in the alternative, this ground of rejection should be withdrawn at least for Claims 31, 54, 129-132, 134-136, 138, 140-142, 157-160, 162-164, 166, 168-170, and 183-185, each of which contains a further limitation directed to the rice plant with ATCC accession number PTA-904.

6. The Prior Art Rejection

All Claims were rejected under 35 U.S.C. § 102(b) or § 103(a) as being anticipated by, or obvious over Terakawa.

For the reasons given in the May 16, 2003 Amendment and the January 12, 2004 Request for Continued Examination – reasons that will not be repeated in the

interest of brevity – it is respectfully submitted that the prior art rejections should be withdrawn.

In addition, the Office has apparently acknowledged that the Claims as presently amended should be free of the prior art. In responding to an earlier argument by Applicant concerning the claims that were then pending, the Office said that Applicant's argument concerning the prior art "appear[ed] to be a misinterpretation of the rejection, which is directed to a rice plant that is a derivative of the PTA-904 rice line, not to the specific PTA-904 rice line itself." (August 10, 2004 Office Action, p. 11.) If the undersigned understands the Office's remarks correctly, the Office appears to agree that the PTA-904 rice line is neither taught nor suggested by the cited references.

While reserving the right to present arguments about the canceled subject matter in the future, for example in a continuation application, it is respectfully submitted that the amendment overcomes the prior art rejection based on the broader recitation of "derivatives" of PTA-904.

Strictly in the alternative, this ground of rejection should be withdrawn at least for Claims 31, 54, 129-132, 134-136, 138, 140-142, 157-160, 162-164, 166, 168-170, and 183-185, each of which contains a further limitation directed to the rice plant with ATCC accession number PTA-904.

7. The Provisional Obviousness-Type Double Patenting Rejection over Co-Pending Application S.N. 09/934,973

All Claims were provisionally rejected under the doctrine of obviousness-type double patenting over certain Claims of co-pending application S.N. 09/934,973.

For the reasons given in the May 16, 2003 Amendment and the January 12, 2004 Request for Continued Examination – reasons that will not be repeated in the interest of brevity – it is respectfully submitted that the provisional double-patenting rejection should be withdrawn.

The Office's arguments, however, appear to be based on the "derivative" limitations in the previously presented Claims. As these limitations have been removed from the amended Claims, it is respectfully submitted that the stated basis for the provisional obviousness-type double patenting rejection has been overcome.

Strictly in the alternative, this ground of rejection should be withdrawn at least for Claims 31, 54, 129-132, 134-136, 138, 140-142, 157-160, 162-164, 166, 168-170, and 183-185, each of which contains a further limitation directed to the rice plant with ATCC accession number PTA-904.

The Office's attention is also respectfully directed to M.P.E.P. § 804, Subpart (I)(B): If a provisional double patenting rejection is the only rejection remaining in an application, then the provisional double patenting rejection should be withdrawn and the application should be passed to issue. (If otherwise appropriate, a non-provisional double patenting rejection might then be entered in the other co-pending application. But in the present case the latter non-provisional rejection would in fact be moot, because a terminal disclaimer has previously been filed in the co-pending '973 application over the present application.)

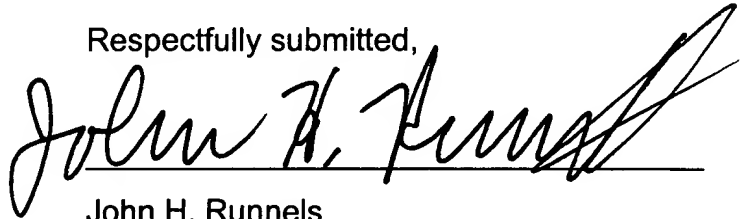
It is respectfully submitted that the provisional obviousness-type double patenting rejection should be withdrawn.

Conclusion

Allowance of all pending Claims at an early date is respectfully requested.

In the alternative, should the Examiner identify any remaining issues, the Examiner is respectfully requested to contact the undersigned to schedule a telephone interview before further action is taken, to discuss whether it might be possible to resolve any such issues quickly, and to conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John H. Runnels", written over a horizontal line.

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September 30, 2004